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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,152	04/19/2004	Takuya Tsukagoshi	890050.481	2674
500	7590	10/13/2006	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 6300 SEATTLE, WA 98104			CHANG, AUDREY Y	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/827,152	TSUKAGOSHI, TAKUYA
	Examiner Audrey Y. Chang	Art Unit 2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 August 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 3-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/14/2006</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 14, 2006 has been entered.
2. This Office Action is also in response to applicant's amendment filed on August 14, 2006, which has been entered into the file.
3. By this amendment, the applicant has amended claims 1, 3, and 6, has canceled claim 2 and has newly added claim 7.
4. Claims 1, and 3-7 remain pending in this application.
5. The objections to claims set forth in the previous Office Action are withdrawn in response to applicant's amendment.

### ***Response to Amendment***

6. The amendment filed **August 14, 2006** is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

**Claims 1, 3 and 6 have been amended** to include phrases “*setting a first optical path ... and setting a second optical path different from the first optical path*”, and “*setting a second optical path of servo beam different from the first optical path of the signal beam*” and the **newly submitted claim 7** recites that “*the first optical path of the signal beam and the second optical path of the servo beam are*

*oblique*" that are not supported by the specification. The specification as explicitly disclosed in *all of the figures* discloses that the optical path for the signal beam and the servo beam are essentially the same, and to the most they are just being focused at different locations but that they have different optical paths.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claims 1, and 3-7 are rejected under 35 U.S.C. 112, first paragraph,** as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The reasons for rejections based on the newly added matters are set forth in the paragraph above.

9. **Claims 1, and 3-7 are rejected under 35 U.S.C. 112, first paragraph,** as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification and the claims fail to teach why the diffraction (235) as shown in Figure 2 is capable of making the servo beam and the signal beam that incident on the diffraction grating in the SAME optical path and SAME incidence angle to be deflated differently. This generally will not happen for an ordinary diffraction grating. The specification and the claims fail to teach what essential feature

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will make this happen which make the claimed feature concerning the optical path of the signal beam and the optical path of the servo beam being different from each other non-enable by the disclosure.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1, 3, 4 and 6 and newly added claim 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent application publication of Horimai (US 2003/0063342 A1) in view of the patent issued to Amble et al (PN. 6,738,322).**

Horimai teaches an apparatus and method for *holographically recording optical information* wherein the apparatus is comprised of a *holographic recording medium* (1, Figure 1) having a *holographic recording layer* (3) and a *servo layer* (4), wherein the serve layer has regions in which *address servo area* (6) having a plurality of embossed servo pits, that serves as the *servo projection structures* for modulating a servo beam (please see paragraph [0136]), are formed. Horimai teaches that the *holographic information* is recorded by projecting a *signal beam*, (such as 51L Figure 7) via a *spatial light modulator* (18) for imparting signal information, and a *reference beam* (such as 51R), and the holographic recording is a recording of the *phase information* of the interfering signal and reference beams. The retrieve of the recorded holographic information is by projecting only the reference beam to the holographic recording medium to reproduce the holographic information. Horimai further teaches that an *objective lens* (12, Figure 1) is used to focus the signal beam on the holographic recording layer (3). The signal beam and the reference beam are being projected to the holographic recording medium via *projection optics* including *prism blocks* (15 and 19) and the *objective lens*. The optical paths of the

signal beam and reference are also implicated set up by the projection optics. Horimai et al also teaches that *a servo beam* can also be projected via *projection optics* such as the prism blocks (15 and 19) and via the objective lens to the *specific locations* of the address servo areas (6) to retrieve the servo signal. It is implicitly true that since the address servo areas (6) are **only** located at certain positions of the servo layer the beam path for the servo beam and the beam path for the signal or reference beam are either implicitly *different* or would have been obvious to one skilled in the art to specifically make it different by *moving the objective lens* via the *actuator* (13, Figure 1) so that the retrieving of the servo information and the retrieving of the recorded holographic information will not be interfering each other to reduce the possible reading noise, (please see paragraphs [0123] to [0136]). **Claims 1, 3 and 6 nave been amended** that the optical path for the signal beam and the optical path for the servo beam are different. This feature is implicitly included by the structure of Horimai since Horimai teaches that the servo pits or the servo projection structures (6, Figure 1) essentially are located at different locations from the hologram recording layer (3) which means that in order for the servo beam to reach the servo projection structures and for the signal beam to reach the hologram recording layer, they have to follow different optical path. With regard to claim 7, it is implicitly true that the actuator will be able to make the servo beam and signal beam to be at oblique angle.

**With regard to** the feature that the holographic recording beams and the servo beam are being generated by two light sources of different wavelength, recited in claim 1, 3 and 6, Horimai et al does not teach such explicitly. Amble et al in the same field of endeavor teaches an optical data storage system with focus and tracking errors wherein the holographic recording beams and the servo beam are generated by two light sources wherein the holographic data are recorded with wavelength of 532 nm and the servo beam is generated by light source (26, Figure 1) with wavelength 780 nm to avoid the cross talk and unwanted interference between the holographic recording and retrieving beams and the servo signal detecting beam. Amble et al also teaches explicitly that the signal beam in the holographic recording and

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the servo beam for detecting servo projection structures are of different optical paths, (please see Figure 3C and 3E).

With regard to claim 4, these references do not teach explicitly that the incident angles for the signal beam and the servo beam at the object lens are different from each other. However in order for the servo beam and the signal beam to reach servo projection structures and the hologram recording layer located at different locations, such features will be implicitly include in order for the beams to be send to different locations via the objective lens.

**12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the patent issued to Horimai in view of the patent issued to Amble et al as applied to claim 3 above, and further in view of the patent issued to Matsui (PN. 5,784,353).**

The apparatus and method for holographic data storage taught by **Horimai** in combination with the teachings of **Amble et al** as described for claim 3 above have met all the limitations of the claim. **Horimai** et al teaches that actuator (13) could be used to move the objective lens (120 for regulating the beam optical paths. However it does not teach explicitly to include a diffraction grating as a deflecting means for deflecting the servo beam to the desired location. However diffraction grating is known in the art has as light beam deflection means for the essential diffraction property of the incident light. **Matsui** in the same field of endeavor also teaches an apparatus for initializing optical disk including detecting servo signal from the optical disk wherein a servo beam is projected by the projection optics including *diffraction gratings* (103 and 104) as deflecting means and the dichroic mirror (106) for projecting the servo beam to the recording medium. It would have been obvious to one skilled in the art to apply the teachings of **Matsui** to include diffraction gratings as beam deflection means in the servo beam projection optics of **Horimai** for the benefit of making the servo beam reaches desired locations and for efficiently retrieving the servo signal.

**13. Claims 1, 3-4 and 6 and newly added claim 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent issued to Amble et al (PN. 6,738,322).**

Amble et al teaches an *optical data storage system* and *method* with focus and tracking error correction wherein the system comprises a *holographic recording medium* having a *recording medium* (20, Figures 1 and 2 or 90 in Figure 3A to 3E or 128 in Figures 5A to 5D, 140 in Figures 6A to 6D), for recording a holographic data including phase information of light by projecting a *signal beam* and a *reference beam* (100A and 100B), emitted by a *first* light source of 532 nm wavelength. The holographic recording medium further comprises a *servo layers* (94, Figures 3A to 3E, 120 Figures 4A to 4D, 132 Figures 5A to 5D, 144 Figures 6A to 6D) that is located at opposite side of the recording layer as viewed in a direction of signal beam incidence on the holographic recording pattern. The holographic recording medium within the recording layer has holographic data recorded therein and the servo layer has *servo pattern* or grooves served as the *servo projection structures* formed within. Amble et al teaches that the system includes a *second light source* (26, Figures 1 and 2) having wavelength of 780 nm for generating the *servo beam* passing through an objective lens (14) to reach the servo pattern via a servo beam optical path. The signal beam is directed to the recording layer along a signal beam optical path as shown in Figures 3C, 4B, 5B, and 6B.

Claims 1, 3 and 6 have been amended to include the feature that the optical path for the signal beam and optical path for the servo beam are different. Amble et al teaches such explicitly as demonstrated by Figure 3C and Figure 3E. With regard to newly added claim 7, the optical paths are oblique to each other.

This reference has met all the limitations of the claims with the exception that it does not teach *explicitly* that the signal beam is directed to regions of the servo layer where the servo pattern is not formed. However since the holographic data is recorded in the recording layer and the servo patterns are

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formed in the servo layer and the since different light beams are used to record and retrieve holographic data and to detect the servo patterns, it would have been obvious to one skilled in the art to make the signal beam not to projected to the regions of the servo patterns to make the holographic data recorded at different general locations as compared to the servo pattern to avoid interference between the retrieving of holographic data and detection of the servo patterns.

With regard to claim 4, this reference does not teach explicitly that the incident angles for the signal beam and the servo beam are different when incident on an objective lens, however since the optical paths for the signal beam and servo beam are different from each other, such feature will have to be implicitly included if there is an objective lens used to direct both the signal beam and the servo beam.

#### ***Double Patenting***

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. **Claims 1, and 3-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 4 of copending Application No. 10/800,607.** Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose a holographic recording and reproducing method and

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apparatus that is comprised of a holographic recording medium having a recording layer and a servo layer having optical modulated pattern formed wherein the servo layer is placed at opposite side of the recording layer viewed in the direction of the signal beam.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

16. Applicant's arguments with respect to amended claims 1, 3-6 and newly added claim 7 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments are mainly drawn to newly amended features that have been fully addressed in the paragraphs above. Applicant fails to provide arguments for the double patenting rejection to overcome the rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Audrey Y. Chang whose telephone number is 571-272-2309. The examiner can normally be reached on Monday-Friday (8:00-4:30), alternative Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A. Chang, Ph.D.

*Audrey Y. Chang, Ph.D.  
Primary Examiner  
Art Unit 2872*